

Remarks

By the foregoing Amendment, claims 1, 4 27, and 28 are amended, and new claim 30 is presented. No new matter is added by this Amendment. Entry of the Amendment, and favorable consideration thereof, is earnestly requested.

Paragraphs 0027 and 0028 have been amended to correct inadvertent errors.

Claim 4 has been amended to correct an inadvertent error resulting in an error in its dependency.

The Examiner has rejected independent claims 1, 27, and 28 under 35 U.S.C. §102(b) as anticipated by Collins, U.S. Patent No. 2,246,932. Accordingly, these claims have been amended. Applicant respectfully requests reconsideration of the rejections in light of these amendments and the below remarks.

Independent Claims 1 and 28

Collins does not anticipates either claim 1 or claim 28, as amended, because Collins does not disclose all of the elements in either of these claims. Specifically, with respect to claim 1, Collins does not disclose *a (second) conduit by which fluid in said first fluid chamber is directly communicated to the outlet port when said pumping device*

is moved toward the second position and fluid in said first fluid chamber is communicated to said second chamber. Similarly, with respect to claim 28, Collins does not disclose compressing fluid in a first compression area and then urging a first volume of the compressed fluid through the outlet while urging a second volume of the compressed fluid to a second compression area.

In other words, both claim 1 and claim 28 recite the feature of discharging some of the fluid in the first chamber out through the outlet port thereof while, at the same time, communicating some of the fluid in that chamber to a second chamber for further compression. As a result, the present invention is able to achieve one of the primary objectives of the invention, which is to continually provide a pump that supplies a significant amount of compressed air that is interspersed with slightly cooler air (to avoid the numerous problems associated with the very hot air that typically results from two stage compressions) and to provide for reduced "pounding" effects. See *Specification, Paragraphs 0005-07*. Collins has no such aims, and thus, provides no disclosure or suggestion of such a feature.

In fact, Collins specifically teaches away from this sort of continuous discharge of fluid though the outlet by communicating some of the fluid in the outlet directly to the outlet while the rest is being communicated to the second compression chamber. Specifically, Collins teaches that, when the pump is operating in two stage mode (i.e., when the valve 28 opens to communicate fluid from chamber C1 to chamber C2 via passageway 25), the outlet port is closed and does not discharge air. See Page 2,

Col.4, lns. 31-36. Instead, the reference teaches that, in the vacuum pump of Collins, the discharge valve 19 in the wall 7 (as well as the inlet valve 18 in the wall 8) will not function due to the change in pressures.

Claim 27

Independent claim 27 has been amended to incorporate the features of claims 2 and 4. Applicant notes that the Office Action included a rejection claim 4 under 35 U.S.C. 35 U.S.C. §103 as obvious over Collin at the time of the invention in view of Braun, U.S. Patent No. 4,111,609, and further in view of Mori, U.S. Patent No. 6,817,838. Applicant respectfully submits that claim 27, as amended, is patentable over the cited art for the reasons set forth below.

First, Applicant notes that Collins does not anticipate claim 27, as amended, because all of the elements recited in claim 27 are not disclosed in the reference. As noted by the Examiner, Collins does not disclose a housing that at least partially encloses a drive shaft chamber, nor an oil seal to separate this drive shaft chamber from a piston channel.

The Office Action, however, indicates that one skilled in the art would have modified the Collins device "in order to make the compressor more aesthetically pleasing (Braun, Abstract, lines 5-8)." Applicant respectfully submits that this is an

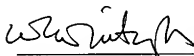
unfair statement. Braun discloses the use of a particular type of housing—namely, one with large fluid flow passageways cast therein, in order to eliminate external piping and thereby improve the look of the compressor. This has nothing to do with employing a housing with a drive shaft chamber for accommodating a drive shaft, as well as a seal to prevent the flow of oil between the drive shaft chamber and the pistol channel. There is no disclosure or suggestion in Collins that the pump is even connected to a drive shaft, and therefore, there would be no motivation for one skilled in the art to employ a housing that accommodates such, much less an oil seal for sealing it off from the piston channel. Applicant respectfully notes that, in order for the claimed invention to be obvious over the prior art, there must be some suggestion or motivation in the reference to make the relevant modification. See, e.g., MPEP 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."). Specifically, it is well settled that the mere fact that a reference *is capable of being* modified does not render a resultant modification obvious *unless the prior art also suggests the desirability of the combination or modification*. In *re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so" in order for obviousness to exist). See also, *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to combine must be found in the prior art, not the applicant's disclosure). Here, there is not even any teaching of the use of a drive shaft to power the vacuum

pump of Collins, and thus, there is no suggestion to employ a housing with a drive shaft chamber, much less a suggestion to use an oil seal to seal off that drive shaft chamber from a piston channel.

It is respectfully submitted that claims 1-30, all of the claims remaining in the application, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,

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